

## REMARKS

This is a full and timely response to the non-final Office Action mailed June 1, 2007. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Present Status of Patent Application**

Claims 1- 20 and 22-36 are pending in the present application. Specifically, claims 10-11, 13-15, 23-25, 27, 30, and 35 are original unamended claims; claims 1-9, 12, 16-20, 22, 26, 28, 29, 31-34, and 36 have been currently amended without introduction of new matter; and claim 21 has been canceled without waiver, disclaimer or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Claim Rejections under 35 U.S.C. §102**

#### **Statement of the Rejection**

*Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Juels et al. (U.S. Patent No. 7,197,639 B1), hereinafter "Juels".*

#### **Response to the Rejection**

##### **Claim 12**

In the interests of moving forward prosecution in this case and clarifying the scope of claim 12, Applicants have opted to amend the claim.

Currently amended claim 12 includes, in pertinent part: "*receiving a REJECT response from the cancellation server as a result of the identifier being already present in a database of the cancellation server*" (Emphasis added).

Applicants have described this aspect in the Detailed Description section of their specification, for example, in paragraph [0038]. Applicants have further pointed out in the Background section of their specification (for example in paragraphs [0006] – [0008]) that the prior art (such as the cited prior art of Juels) suffers from several handicaps when using a cryptographic puzzle. Currently amended claim 12 is directed towards a solution that overcomes such handicaps, and Applicants respectfully assert that the elements of claim 12 are not disclosed or taught in the cited prior art of Juels.

Consequently, Applicants submit that currently amended claim 12 is now allowable and hereby request withdrawal of the rejection under 35 U.S.C. § 102, followed by allowance of the claim.

### **Claim Rejections under 35 U.S.C. §103**

#### **Statement of the Rejection**

*Claims 1-11, 13-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juels et al (US Patent 7,197,639 B1) in view of Landsman et al. (US Pub. No. 2005/0055410 A1), hereinafter "Landsman".*

#### **Response to the Rejection**

The MPEP provides several guidelines for rejecting a claim under 35 U.S.C. 103(a). Specifically, reference is made to MPEP 706.2(j) *Contents of a 35 U.S.C. 103 Rejection*, which states in pertinent part:

To establish a *prima facie* case of obviousness, **three basic criteria** must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.  
(Emphasis added)

In light of the MPEP guidelines above, Applicants respectfully traverse the rejection of claims 1-11 and 13-36. Remarks addressed towards each of these rejected claims are provided below.

#### **Claim 1**

In rejecting Applicants' claim 1, the Office Action admits that Juels does not specifically mention the database. However, the Office Action then asserts that Landsman discloses a database and "*it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Landsman into the method of Juels to couple the cancellation server to a database,*" because "*Landsman's teaching could enhance Juels's system.*" Applicants respectfully traverse the Office Action assertion because

the motivation that has been provided to combine Landsman with Juels is inadequate. Specifically, there are several things that can be done to enhance Juels' system. For example, it can be argued that Juels' system may be potentially enhanced by installing it inside a waterproof housing. However, a person of ordinary skill in the art can appreciate that such an enhancement is not necessarily obvious or desirable unless there was a reasonable motivation to do so. Similarly, in the present instance, a valid motivation or suggestion must exist to modify Juels by combining Juels with Landsman. The Office Action fails to disclose such a motivation or suggestion and consequently fails to satisfy the first criterion for establishing a *prima facie* case of obviousness.

The Office Action further fails to satisfy the third criterion vis-à-vis the prior art references must combinedly teach or suggest all claim limitations. In this matter, the Office Action fails to disclose where in the cited art can be found each of the elements of Applicants' claim 1. For example, the Office Action fails to disclose anticipatory art for the steps of: "querying the at least one database with the identifier;" the step of "canceling the intended recipient's puzzle;" and the portion that cites "the entry comprises the identifier or information derived from the identifier." It is unfortunate that the rejection glosses over (or completely omits addressing) these, and other, elements of Applicants' claim 1. A proper rejection requires that the Office Action clearly identify anticipatory art for each individual element of a claim so as to provide Applicants an opportunity to respond to the rejection in a detailed manner.

In addition to the shortcomings listed above, Applicants' respectfully draw attention to the portion (page 4, paragraph [0042]) of Landsman that has been cited in the Office Action. This portion discloses (in lines 6-8) that Landsman's "*recipient server 16 may determine whether the sender is designated in a sender database 56 as being authorized (or unauthorized) to send electronic messages to the recipient*" (Emphasis added). While Landsman's database pertains to a list of senders, Applicants' database of claim 1 is associated with identifiers pertaining to cryptographic puzzles. Consequently, Applicants respectfully assert that Landsman's database bears no direct relevance to Applicants' database and therefore does not constitute anticipatory art pertinent to Applicants' claim 1.

In light of at least the reasons listed above, Applicants respectfully assert that the rejection not only fails to satisfy the first criterion but also fails the third criterion for

establishing a *prima facie* case of obviousness as is necessary for making a proper rejection under 35 U.S.C. 103(a).

Regardless of the impropriety of the rejection, Applicants have opted to currently amend claim 1 so as to clarify the scope of the claim, and consequently assert that the claim is allowable in its current form. For example, currently amended claim 1 includes:

*“validating the identifier by verifying that the identifier does not exist in the at least one database,”* and

*“upon validating, canceled the intended recipient’s cryptographic puzzle.”* These and other elements of currently amended claim 1 are not disclosed or taught, individually or combinedly, in the cited prior art.

Therefore, for at least the reasons provided above, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 1.

#### **Claims 2-11**

Applicants respectfully assert that each of the claims 2-11 is allowable for a variety of reasons. However, in the interests of brevity, Applicants have opted to refrain from outlining these details at this stage. Suffice to point out that independent claim 1 is allowable for reasons cited above. Consequently, claims 2-11 that are dependent directly or indirectly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

For at least this reason, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a) followed by allowance of claims 2-11.

#### **Claims 13-20**

Applicants respectfully assert that each of the claims 13-20 is allowable for a variety of reasons. However, in the interests of brevity, Applicants have opted to refrain from outlining these details at this stage. Suffice to point out that independent claim 12 is allowable for reasons cited above. Consequently, claims 13-20 that are dependent directly or indirectly on claim 12 are also allowable as a matter of law, and for at least this reason, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a) followed by allowance of claims 13-20.

#### **Claim 21**

Applicants have currently canceled claim 21 and respectfully submit that the rejection of this claim has been rendered moot as a result of the cancellation.

**Claim 22**

The Office Action rejection of claim 22 at least fails to satisfy the third criterion of MPEP 706.2(j) vis-à-vis that the prior art references when combined, must teach or suggest all the claim limitations. Specifically, Applicants respectfully assert that the cited prior art combination fails to disclose “*generating an identifier*” (more so one as defined in dependent claim 23 for example) as well as “*generating a cryptographic puzzle using the identifier.*” In this matter, the Office Action improperly alleges that “*Juels’ figure 8, element 530 ‘other data’* anticipates Applicants’ identifier. Applicants have described their identifier in the Detailed Description section of their specification (for example, in paragraph [0039]) and respectfully submit that Juels does not anticipate the identifier of claim 22.

Applicants therefore respectfully request withdrawal of the rejection for at least the reason that it fails to satisfy the third criterion for establishing a *prima facie* case of obviousness, followed by allowance of claim 22.

**Claims 23-27**

Applicants respectfully assert that each of the claims 23-27 is allowable for a variety of reasons. However, in the interests of brevity, Applicants have opted to refrain from outlining these details at this stage. Suffice to point out that independent claim 22 is allowable for reasons cited above. Consequently, claims 23-27 that are dependent directly or indirectly on claim 22 are also allowable as a matter of law. For at least this reason, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a) followed by allowance of claims 23-27.

**Claim 28**

In contrast to claim 1 which is directed to a cancellation server, claim 28 is directed to a method for using a cryptographic puzzle. Consequently, the scope of claims 1 and 28 are different from one another. However, it can be appreciated that the remarks made above in response to the rejection of method claim 1 are equally applicable to the rejection of claim 28.

Consequently, Applicants respectfully submit that independent claim 28 is also allowable and hereby request withdrawal of the rejection under 35 U.S.C. 103(a), followed by allowance of claim 28.

**Claims 29-35**

Applicants respectfully assert that each of the claims 29-35 is allowable for a variety of reasons. Suffice to point out that independent claim 28 is allowable for reasons cited above. Consequently, claims 29-35 that are dependent directly or indirectly on claim 28 are also allowable as a matter of law. For at least this reason, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. 103(a) followed by allowance of claims 29-35.

**Claim 36**

Applicants have opted to currently amend claim 36 so as to clarify the scope of the claim and respectfully assert that the claim is at least allowable in its current form. For example, currently amended claim 36 includes: “*upon validating, canceling the cryptographic puzzle...*” as well as “*storing in the database a new entry...*” These and other elements of currently amended claim 36 are not disclosed or taught, individually or combinedly, in the cited prior art.

Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 36.

**Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.


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**Office Action Dated:** June 1, 2007

**PATENT**

### **CONCLUSION**

Applicants respectfully submit that pending claims 1- 20 and 22-36 are allowable. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative.

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